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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/559,783	12/08/2005	Mitsuko Kosaka	64614(70904)	1080
21874 7590 11/03/2009 EDWARDS ANGELL PALMER & DODGE LLP P.O. BOX 55874 BOSTON, MA 02205				
EXAMINER				
DUTT, ADITI				
ART UNIT		PAPER NUMBER		
1649				
MAIL DATE		DELIVERY MODE		
11/03/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Advisory Action**  
**Before the Filing of an Appeal Brief**

**Application No.**

10/559,783

**Applicant(s)**

KOSAKA, MITSUKO

**Examiner**

Aditi Dutt

**Art Unit**

1649

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 08 October 2009 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 6 months from the mailing date of the final rejection.  
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.  
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: \_\_\_\_\_.  
Claim(s) objected to: \_\_\_\_\_.  
Claim(s) rejected: 1-4, 6, 17, 18, 26 and 27.  
Claim(s) withdrawn from consideration: 12-14.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See continuation below.  
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_.  
13. ☐ Other: \_\_\_\_\_.

/Jeffrey Stucker/  
Supervisory Patent Examiner, Art Unit 1649

/A. D./  
Examiner, Art Unit 1649

Continuation of 11: Does not place the application for condition of allowance because:

The rejection of claims 1-4, 6, 17-18 and 26-27, as being as being unpatentable over Kosaka et al. (Exp Cell Res 245: 245-251, 1998), and Tropepe et al. (Sc. 287: 2032-2036, 2000), in view of Pardo et al. (Brain Res 818: 84-95, 1999), and further in view of Lee et al (Theriogenology 44: 71-83, 1995) and Samarut et al., (US Patent number 6,500,668, dated 31 December 2002), as evidenced by Reynolds et al. (Sc. 255: 1707-1710, 1992) and Kitchens et al. (J. Neurobiol 25: 797-807, 1994), is maintained for reasons of record in the last Office Action dated 8/13/09.

Applicant has largely repeated the same arguments as described in the previous Office Action dated 13 August 2009. Even though Applicant acknowledges that "all of the components of the instantly claimed invention may have been known in the art at the time of filing", Applicant alleges that the combination of the references could only be made in hindsight. Applicant's reasoning is based on two separate rejections in two Office Actions, arguing that if a skilled artisan could not practice the method due to undue experimentation as alleged in a previous Office Action, one would not combine references to provide the instant invention without a reasonable expectation of success. Furthermore, Applicant asserts that none of the seven references disclose or suggest the specific differentiation conditions as currently claimed, i.e. the references taken individually or in combination do not teach the floated coagulated mass culture method in serum free media containing N2 supplement and at least one of FGF, LIF or SCF. Applicant asserts that the cited references do not disclose these conditions and therefore, the instant invention is not obvious in view of the references.

Applicant's arguments are fully considered, however, are not found to be persuasive for reasons largely provided in the last Office Action (see pages 7-12). Additionally, Applicant's arguments over the invention as involving undue experimentation in one Office Action, while being shown as obvious in the next Office Action is inappropriate, especially because Examiner withdrew the rejection over lack of enablement before proceeding to show obviousness over the prior art teachings. Furthermore, Applicant is arguing limitations that are not present or required in the current claims. For example the differences in cell types IPE versus RPE, and the selection of culture medium to deal with the differences, is not relevant to the instantly claimed invention, particularly when the combined teachings clearly render the claimed invention obvious to the skilled artisan. As far as improper hindsight reasoning is alleged, it is reminded herein that "[a]ny judgement on obviousness is in a sense necessarily a reconstruction based on hindsight reasoning, but so long as it takes into account only knowledge which was within the level of ordinary skill in the art at the time the claimed invention was made and does not include knowledge gleaned only from applicant's disclosure, such a reconstruction is proper." In re McLaughlin 443 F.2d 1392, 1395, 170 USPQ 209, 212 (CCPA 1971). The prima facie obviousness of the claimed invention in view of the combined references, therefore, provides sufficient reasoning, and nullifies Applicant's allegations of improper teachings in the individual references.

Lastly, a substantial focus of Applicant's current arguments is based on the proposed amendments of independent claim 1 that contain subject matter not presented in the previous set of independent or dependent claims, thus will require further search and examination. The rejection under 35 U.S.C.103(a) is therefore, maintained.